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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,560	07/30/2003	Janusz Jachowicz	FDN-2805	8640

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INTERNATIONAL SPECIALTY PRODUCTS
Attn: William J. Davis, Esq.
Legal Department, Building No. 10
1361 Alps Road
Wayne, NJ 07470

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1619

MAIL DATE	DELIVERY MODE
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06/23/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/630,560	Applicant(s) JACHOWICZ ET AL.	
	Examiner JYOTHSNA A. VENKAT	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/28/10.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/28/10 has been entered.

Receipt is acknowledged of remarks and declaration under 1.131 filed on 4/28/10 Claim 49 has been canceled as per applicants' amendment dated 11/18/08. Claims 1-48 are currently pending in the application.

Claim Rejections - 35 USC § 102

Claims 1-14 and 16-47 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent 7,223,294 ('294).

See col.11, line 22 through col.12, line 63 for the claimed cationic polymer formed from a, b and c. see the proviso at col.12, which states that if m and n are equal to zero, then p or q is equal to zero. See col.13, ll 4-13 for the species of cationic polymer and these are same as species claimed in claim 8. See col.21, line 54 through col.28, line 28 for the claimed conditioning agent, which is cationic polymer. See col.4, line 36 through col.6, line 45 for anionic polymer of claim 19, see col.28, line 29 through col.33, line 25 for amphoteric polymers of claim 20 and claims 35-39, see col.14, line 54 through col. 15, line 48 for nonionic polymer of claim 21 see especially col.15, under (4) this is same as claimed copolymers of alkyl acrylates and alkyl methacrylates, see col.15, ll 29-34 for claim 22, which is non-silicone polyurethanes.

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See col.34, ll 27-48 for claims 25-29 and 42, see col.34, ll 12-19 for claims 30-31, see col.16, line 65 through col.21, line 28 for claims 32-34, see col.34, ll 44-68 for claims 40-41 belonging to non-ionic surfactant, see col.33, ll 26-33 for claim 43, see col.34, ll 1-111 for claim 44 and see col.34, line 49 through col.35, ll 1-7 for claims 45-47.

Response to Arguments

Applicant's arguments filed 4/28/10 have been fully considered but they are not persuasive.

Response to Amendment

The declaration filed on 4/28/10 under 37 CFR 1.131 has been considered but is ineffective to overcome the 102 (e) reference.

The reasons are :

1. The declaration is signed by only one inventor (Linda Foltis). The declaration is not signed by all the inventors.
2. The declarant under 4) states that prior to December 21,2001 ISP provided certain polymers including "ACP 1234" described in the application to L'Oreal as apart of ongoing marketing research and point to exhibit A drawn to presentation of the polymers. However the presentation only includes " ACP 1234" polymer and this appears to correspond to last polymer drawn to chloride species claimed in claim 8, which is vinylpyrrolidone (VP)/dimethylaminopropylmethacrylamide (DMAPMA)/lauryldimethylmethacrylamidopropylammonium chloride terpolymer. The proposed abbreviation for dimethylaminopropylmethacrylamide is (DMAPMA) and the same is

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used for dimethylmethacrylamidopropylammonium. Detailed explanation is requested for the abbreviation being same for two different moieties.

Patent '294 discloses the claimed genus. Patent '294 also discloses claimed species.

Applicants' attention is drawn to col.13, ll 4-13 where patent '294 discloses the species.

See below.

Cationic poly(vinylactam) polymers according to the invention that are especially used include vinylpyrrolidone/ 5 dimethylaminopropylmethacrylamide/dodecyldimethylmethacrylamidopropylammonium tosylate terpolymers, vinylpyrrolidone/dimethylaminopropylmethacrylamide/cocoyldimethylmethacrylamidopropylammonium tosylate terpolymers and vinylpyrrolidone/dimethylaminopropyl- 10 methacrylamide/lauryldimethylmethacrylamidopropylammonium tosylate or chloride terpolymers.

The same species are claimed in claim 8. See below for claim 8.

8. (Original) The composition of Claim 1 wherein said cationic polymer is a terpolymer selected from the group consisting of vinylpyrrolidone/dimethylaminopropylmethacrylamide/ dodecyldimethylmethacrylamidopropylammonium tosylate terpolymers, vinylpyrrolidone/dimethylaminopropylmethacrylamide/ cocoyldimethylmethacrylamidopropylammonium tosylate terpolymers, vinylpyrrolidone/dimethylaminopropylmethacrylamide/lauryldimethylmethacrylamidopropylammonium tosylate or chloride terpolymers.

The declaration failed to show that applicants' completed prior to the date of the reference all of the species shown in the reference. Se In re Stempel 113 USPQ 77

Therefore the rejection is maintained.

Claim Rejections - 35 USC § 103

Claims 1-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 7,223,294 ('294) and 6,540,791 ('791) and WO 01/41722 (WO document) and 6,984,250 ('250).

Examiner is relying on patent '250, which is English equivalent for WO document. Patent '294 does not disclose the limitation of claim 15, wherein the conditioning agent is drawn to various silicone compounds and limitation of claim 48, wherein the composition is an anhydrous composition. Patent '791 teaches bleaching compositions (personal care compositions for hair) using conditioning agents. Patent at col.4, line 50 through col. 22, line 41 teaches claimed silicone compounds as conditioning agents. Patent at col.26, ll 29 through col.30, line 32 teaches cationic polymers claimed in claim 14 also as conditioning agents. Thus patent teaches the equivalency between cationic polymers and silicones. Cationic polymers are taught in patent '294. Patent '791 also teaches claimed oxidative hair coloring agent, surfactants, and dyes. English equivalent of WO document, which is patent '250 teaches bleaching compositions (personal care compositions for hair) and teaches these compositions can be in anhydrous form at col.1, ll 39-41 and col2, ll 33-35.

Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of patent '294 and substitute the conditioning agent, which is cationic polymer of patent '294 with silicones as the conditioning agent in view of equivalency between both the conditioning agents taught by patent '791, expecting silicones to provide conditioning property to hair and prepare the compositions in anhydrous form taught by

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WO document that personal compositions for hair (bleaching) can be an anhydrous form. This is a prima facie case of obviousness.

Response to Arguments

Applicant's arguments filed 11/18/08 have been fully considered but they are not persuasive.

Applicants' argue that patent '294 is not a valid reference in view of the 1.131 declaration.

In response, the declaration is ineffective for the reasons stated *supra* and patent '294 is a competent reference under 102 (e) and therefore 103 rejection is deemed proper for the reasons stated in the final rejection dated 3/27/09.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EYLER YVONNE (BONNIE) can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619